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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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09/441,832 11/17/99 LAWSON C 2870/192

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HM12/0205

EXAMINER

BERMAN, A

ART UNIT

PAPER NUMBER

1619

DATE MAILED:

02/05/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/441,832

Applicant(s)

LAWSON ET AL.

Examiner

Alysia Berman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 4-6, 20, 22 and 24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 7-19, 21, 23, 25 and 26 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claims ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

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DETAILED ACTION

1. Receipt is acknowledged of the information disclosure statement filed February 7, 2000. Claims 1-26 are pending.

Election/Restrictions

2. This application contains claims directed to the following patentably distinct species of the claimed invention:
 - a. carbohydrate based surfactant/emulsifier and
 - b. sterol-based surfactant/emulsifier.
3. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-3, 9-19, 23 and 25-26 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims

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are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

4. During a telephone conversation with Karen Lowney on January 19, 2000 a provisional election was made without traverse to prosecute the invention of species (b) sterol-based surfactant/emulsifier, claims 1-3, 7-19, 21, 23 and 25-26. Affirmation of this election must be made by applicant in replying to this Office action. Claims 4-6, 20, 22 and 24 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Oath/D clARATION

6. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

Maintain

The oath or declaration is defective because:
It does not identify the post office address of each inventor. A post office address is an address at which an inventor customarily receives his or her mail and may be either a home or business address. The post office address should include the ZIP Code designation.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-3, 7, 9-19, 23, 25 and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Maintain*
9. The terms "carbohydrate-based" and "sterol-based" in claims 1, 7, 15 and 16 render the claims indefinite. It is unclear what is Applicants' intent is with regard to these terms. The metes and bounds of the claims cannot be determined.

- Draw*
10. The term "substantially" in claims 1, 15 and 16 is a relative term which renders the claims indefinite. The term "substantially" is not defined by the claims, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The metes and bounds of the claims cannot be determined.

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11. Claims 1-3, 7, 9-19, 23, 25 and 26 are indefinite because claims 1, 15 and 16 recite "substantially no oil". The term substantially is a relative term. Neither the claims nor the specification give a clear definition of what is meant by "substantially no oil". The metes and bounds of the claim cannot be determined.

12. Claim 2 recites the limitation "amine" in line 2. There is insufficient antecedent basis for this limitation in the claim.

13. Claims 9 and 23 are confusing because they appear to recite an additional limitation that is not recited in the parent claims. Amendment of the claims to read "which **further** contains" is suggested.

14. The recitation of the colors in parentheses in claim 10 renders the claim indefinite. It is unclear if the colors in the parentheses are required limitations of the claims.

15. Claims 15 and 16 are indefinite because it is unclear if Applicants' intent is to claim an amine or an amine salt of a fatty acid for component (b). Amendment of the claims to read "an amine salt of a fatty acid or an alkali metal salt of a fatty acid" would overcome this rejection.

Claim Rejections - 35 USC § 102

16. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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17. The instant application is directed to a non-emulsion gel composition comprising
- a. an aliphatic polyhydric alcohol (isoprene alcohol - claims 13 and 19),
 - b. an alkali salt of a fatty acid ester (sodium behenate or potassium behenate – claims 3 and 18),
 - c. a sterol-based surfactant/emulsifier (cholesterol or a phytosterol – claims 8 and 21),
 - d. water and
 - e. substantially no oil.
18. Claims 1, 2, 7-11 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,567,420 ('420).

US '420 discloses a colored cosmetic composition in the form of a gel (abstract and claims 1 and 9). For polyhydric alcohols and water, see column 3, lines 38-40, column 5, line 58, Table 1 at column 9, and claim 9. For pigments such as titanium dioxide, talc and kaolin in an amount from about 2-25 wt.% and 1-10 wt.%, respectively, see column 5 lines 1-8 and claim 10. For sterols see column 5 line 61. For fatty acid

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cholesterol derivatives and phytosterols, see column 6, lines 48-51, column 8, lines 6, 19-20 and 26. For fatty acid alkali metal salts, see column 8, lines 49-50.

20. The use of a substance in a composition does not render the instantly claimed composition patentable over the prior art composition containing that substance. See *In re Tuominen*, 213 USPQ 89, *In re Spada* 15 USPQ 1655, MPEP §2112.01 and *In re Pearson*, 181 USPQ 641.

Claim Rejections - 35 USC § 103

21. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

22. This application currently names joint inventors. In considering patentability of

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US '420 and US '049 each teach all the limitations of the claims as stated above. They do not teach the amounts of components as instantly claimed in claims 15 and 16. It is within the skill in the art to select optimal parameters, such as amounts of ingredients, in a composition in order to achieve a beneficial effect. *In re Boesch*, 205 USPQ 215 (CCPA 198).

It would have been obvious to one of ordinary skill in the art at the time of the invention to prepare the composition of either US '420 or US '049 and select optimal amounts of components with the expectation of obtaining a composition that provides moisturizing benefits to the skin.

24. Claims 3 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over either US '420 or US '049 each as applied to claims 1, 2, 7-11, 14-17, 21, 23 and 25 above, and further in view of US 5,424,070 ('070).

US '420 and US '049 teach all the limitations of the claims as stated above. They

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25. Claims 12, 13, 19 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over either US '420 or US '049 each as applied to claims 1, 2, 7-11, 14-17, 21, 23 and 25 above, and further in view of US 5,741,499 ('499).

US '420 and US '049 teach all the limitations of the claims as stated above. They do not teach isoprene glycol or pigment coated with dimethicone. US '499 teaches topical mousse compositions that comprise isoprene glycol (col. 7, line 2) and pigments that may be coated with silicone compounds (col. 8, line 66 to col. 9, line 15).

It would have been obvious to one of ordinary skill in the art at the time of the invention to prepare the composition of either US '420 or US '049 substituting isoprene glycol and silicone coated pigments as taught by US '499 with the expectation of providing a composition with moisturizing benefits and good color.

26. Claims 12 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over either US '420 or US '049 each as applied to claims 1, 2, 7-11, 14-17, 21, 23 and 25 above, and further in view of US 5,393,526 ('526).

US '420 and US '049 teach all the limitations of the claims as stated above. They do not teach dimethicone-coated pigments. US '526 teaches that colored cosmetic compositions generally require pigments of which dimethicone coated titanium dioxide is preferred (col. 2, lines 53-64).

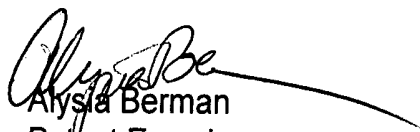
It would have been obvious to one of ordinary skill in the art at the time of the invention to prepare the composition of either US '420 or US '049 substituting dimethicone coated pigments as taught by US '526 with the expectation of providing a cosmetic composition with good color.

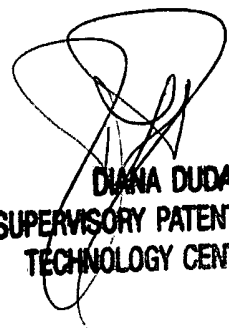
Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alysia Berman whose telephone number is 703-308-4638. The examiner can normally be reached on Monday through Friday from 8:30 to 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diana Dudash can be reached on 703-308-2328. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3592 or 703-305-4456 for regular communications and 703-308-7922 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234 or 703-308-1235.


Alysia Berman
Patent Examiner
January 27, 2001


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